

5-24-05

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Chu *et al.*

Appl. No. 09/438,365

Filed: November 12, 1999

For: **New Transfection Reagents**

Art Unit: To be assigned

Examiner: To be assigned

Atty. Docket: 0942.4650001/RWE/THN

Information Disclosure Statement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. A copy of each of these documents is provided.

The Examiner's attention is directed to co-pending U.S. Patent Application Nos. 08/450,555 filed May 25, 1995 and 09/039,780 filed March 16, 1998, which are directed to related technical subject matter. The identification of these U.S. Patent Applications is not to be construed as a waiver of secrecy as to these applications now or upon issuance of present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned representative submits the following concise explanation of the relevance of the non-English language document, Document No. AL1, cited on Form PTO-1449.

Document No. AL1, European Patent No. EP 0 394 111 B1, is in French. It is believed to disclose lipopolyamines, which are especially useful as vectors for the transfection of eukaryotic

cells, their salts, their preparation and their use. Document No. AE1, U.S. Patent No. 5,171,678, is believed to be an English language equivalent of Document No. A11.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that had been cited or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

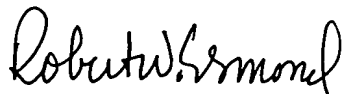
It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and to indicate in the official file wrapper of this patent application that the documents have been considered.

This Information Disclosure Statement is being filed more than three months after the U.S. filing date but before the mailing date of a first Office Action on the merits.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this pleading is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: March 9, 2000

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FORM PTO-1449

INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.
0942.4650001

APPLICATION NO.
09/438,365

APPLICANT
Chu *et al.*

FILING DATE
November 12, 1999

GROUP
To be assigned

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	2,695,314	11/23/1954	Kosmin, M.	260	584	08/25/1951
	AB1	2,901,461	08/25/1959	Auerbach <i>et al.</i>	260	47	05/05/1955
	AC1	3,152,188	10/06/1964	Kirkpatrick, W.H.	260	584	11/15/1960
	AD1	4,897,355	01/30/1990	Eppstein <i>et al.</i>	435	240.2	10/29/1987
	AE1	5,171,678	12/15/1992	Behr <i>et al.</i>	435	172.3	04/17/1990
	AF1	5,208,036	05/04/1993	Eppstein <i>et al.</i>	424	450	11/16/1990
	AG1	5,279,833	01/18/1994	Rose, J.K.	424	450	04/04/1990
	AH1	5,283,185	02/01/1994	Epand <i>et al.</i>	435	172.3	08/28/1991
	AI1	5,334,761	08/02/1994	Gebeyehu <i>et al.</i>	564	197	08/28/1992
	AJ1	5,455,335	10/03/1995	Kahne <i>et al.</i>	536	5	04/08/1994
	AK1	5,459,127	10/17/1995	Felgner <i>et al.</i>	514	7	09/16/1993

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	EP 0 394 111 B1	06/04/1997	Europe			Yes No
	AM1	WO 94/27435 A1	12/08/1994	WIPO			Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	1	Bangham, A.D. <i>et al.</i> , "Diffusion of Univalent Ions across the Lamellae of Swollen Phospholipids," <i>J. Mol. Biol.</i> 13:238-252 (1965).
	AS	1	Behr, J.-P. <i>et al.</i> , "Efficient gene transfer into mammalian primary endocrine cells with lipopolyamine-coated DNA," <i>Proc. Natl. Acad. Sci. USA</i> 86:6982-6986 (September 1989).
	AT	1	Felgner, P.L. <i>et al.</i> , "Lipofection: A highly efficient, lipid-mediated DNA-transfection procedure," <i>Proc. Natl. Acad. Sci. USA</i> 84:7413-7417 (November 1987).

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



FORM PTO-1449

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U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA2	5,545,412	08/13/1996	Eppstein <i>et al.</i>	424	450	04/03/1995
	AB2	5,550,289	08/27/1996	Eppstein <i>et al.</i>	564	293	04/03/1995
	AC2	5,589,466	12/31/1996	Felgner <i>et al.</i>	514	44	01/26/1995
	AD2	5,667,774	09/16/1997	Figuly, G.D.	424	78.08	11/07/1996
	AE2	5,674,908	10/07/1997	Haces <i>et al.</i>	514	642	12/20/1993
	AF2	5,703,055	12/30/1997	Felgner <i>et al.</i>	514	44	01/26/1994
	AG2	5,705,385	01/06/1998	Bally <i>et al.</i>	435	320.1	06/07/1995
	AH2	5,719,131	02/17/1998	Harris <i>et al.</i>	514	44	10/20/1995
	AI2	5,736,392	04/07/1998	Hawley-Nelson <i>et al.</i>	435	320.1	06/04/1996
	AJ2	5,753,613	05/19/1998	Ansell <i>et al.</i>	514	2	05/16/1995
	AK2	5,783,565	07/21/1998	Lee <i>et al.</i>	514	44	02/01/1996

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

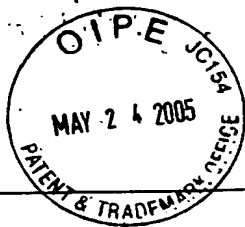
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	2	Fukunaga, M. <i>et al.</i> , "Liposome Entrapment Enhances the Hypocalcemic Action of Parenterally Administered Calcitonin," <i>Endocrinol.</i> 115:757-761 (1984).
	AS	2	Gao, X. and Huang, L., "A Novel Cationic Liposome Reagent for Efficient Transfection of Mammalian Cells," <i>Biochem. Biophys. Res. Comm.</i> 179:280-285 (August 1991).
	AT	2	Hart, S.L. <i>et al.</i> , "Lipid-Mediated Enhancement of Transfection by a Nonviral Integrin-Targeting Vector," <i>Hum. Gene Ther.</i> 9:575-585 (March 1998).

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



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ATTY. DOCKET NO.
0942.4650001APPLICATION NO.
09/438,365APPLICANT
Chu et al.FILING DATE
November 12, 1999GROUP
To be assigned

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA3	5,783,566	07/21/1998	Mislick, K.A.	514	44	05/10/1996
	AB3	5,785,992	07/28/1998	Ansell et al.	424	450	09/29/1995
	AC3	5,795,587	08/18/1998	Gao et al.	424	450	01/23/1995
	AD3	5,830,430	11/03/1998	Unger et al.	424	1.21	02/21/1995
	AE3	5,830,878	11/03/1998	Gorman et al.	514	44	06/07/1995
	AF3	5,834,439	11/10/1998	Haces et al.	514	42	01/13/1997
	AG3	5,837,283	11/17/1998	McDonald et al.	424	450	03/12/1997
	AH3	5,840,710	11/24/1998	Lee et al.	514	44	10/20/1995
	AI3	5,908,635	06/01/1999	Thierry, A.	424	450	08/05/1994
	AJ3	5,935,936	08/10/1999	Fasbender et al.	514	44	06/03/1996
	AK3	5,948,925	09/07/1999	Keynes et al.	552	540	05/06/1997

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

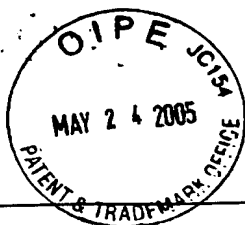
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	3	Kim, S. et al., "Preparation of Multivesicular Liposomes," <i>Biochim. Biophys. Acta</i> 728:339-348 (1983).
	AS.	3	Mayer, L.D. et al., "Vesicles of variable sizes produced by a rapid extrusion procedure," <i>Biochim. Biophys. Acta</i> 858:161-168 (1986).
	AT	3	Mayhew, E. et al., "Characterization of Liposomes Prepared Using a Microemulsifier," <i>Biochim. Biophys. Acta</i> 775:169-174 (1984).

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FORM PTO-1449

INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.
0942.4650001

APPLICATION NO.
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APPLICANT
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U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA4	5,948,767	09/07/1999	Scheule et al.	514	44	07/12/1996
	AB4	5,962,533	10/05/1999	Bergeron, Jr., R.J.	514	674	02/06/1996
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	4	Olson, F. et al., "Preparation of Liposomes of Defined Size Distribution by Extrusion Through Polycarbonate Membranes," <i>Biochim. Biophys. Acta</i> 557:9-23 (1979).
AS	4	Rosenthal, A.F. and Geyer, R.P., "A Synthetic Inhibitor of Venom Lecithinase A," <i>J. Biol. Chem.</i> 235:2202-2206 (August 1960).
AT	4	Szoka Jr., F. and Papahadjopoulos, D., "Procedure for preparation of liposomes with large internal aqueous space and high capture by reverse-phase evaporation," <i>Proc. Natl. Acad. Sci. USA</i> 75:4194-4198 (1978).

EXAMINER

DATE CONSIDERED

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FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 0942.4650001	APPLICATION NO. 09/438,365
	APPLICANT Chu <i>et al.</i>	
	FILING DATE November 12, 1999	GROUP To be assigned

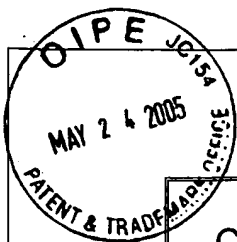
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
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FOREIGN PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR	<u>5</u>	Zhou, X. <i>et al.</i> , "Lipophilic polylysines mediate efficient DNA transfection in mammalian cells," <i>Biochim. Biophys. Acta</i> 1065:8-14 (1991).
	AS	<u>5</u>	Life Technologies Inc. catalogue, <i>Spectrum</i> , pp. 1-8 (September 1999).
	AT		

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

Attorney Docket No.: 61-03

Application No. : 09/438,3659
Applicant: : Chu et al.
Filed: : November 12, 1999
Title: : New Transfection Reagents

I hereby certify that the following correspondence, along with any other document referred to as being attached or enclosed,:

1. **Resubmission of Copies of References Previously Submitted in IDS filed March 9, 2000 – 1 page**
2. **Copy of transmittal letter for previously submitted IDS - 2 pages**
3. **Copy of previously submitted Information Disclosure Statement - 3 pages**
4. **Copy of previously submitted 1449 – 5 pages**
5. **Copy of returned post card - 1 page**
6. **16 references**
7. **Certificate of mailing - 1 page**
8. **Return Postcard**

Is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to:

Commissioner for Patents,
PO Box 1450
Alexandria, VA 22313-1450

On May 24, 2005

LEA MURRAY

(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

EV 663 224 876 US

("Express Mail" Mailing Label Number)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/438,365 Confirmation No.: 9217
Applicant: : Chu et al.
Filed: : November 12, 1999 Group Art Unit: 1635
Examiner: : Epps, J.
For: : New Transfection Reagents

Docket No. : 61-03
Customer No. : 23713

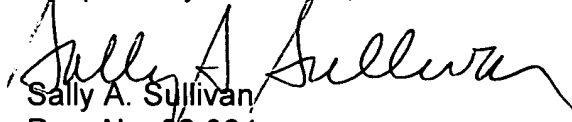
RESUBMISSION OF COPIES OF REFERENCES PREVIOUSLY SUBMITTED
IN INFORMATION DISCLOSURE STATEMENT FILED MARCH 9, 2000

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed are copies of references previously submitted in this case on March 9, 2000 (along with proper 1449 forms) in an Information Disclosure Statement. U.S. patents listed on the 1449 forms have not been resubmitted. This submission results from a telephone request by Examiner Davies. Also enclosed is a copy of the returned post card date-stamped by the Patent Office indicating that the Information Disclosure Statement with 51 references was received on March 9, 2000.

Respectfully submitted,


Sally A. Sullivan
Reg. No. 32,064

GREENLEE, WINNER and SULLIVAN, P.C.
5370 Manhattan Circle, Suite 201, Boulder, CO 80303
Telephone (303) 499-8080; Fax (303) 499-8089
email: ssullivan@greenwin.com
Attorney docket no. 61-03
SAS:lem:2/25/05

Due Date:

Applicants: Chu *et al.*

Art Unit: To be assigned

Examiner: To be assigned

Application No.: 09/438,365

Docket: 0942.4650001

Filed: November 12, 1999

Atty: RWE/THN

For: New Transfection Reagents

- When receipt stamp is placed hereon, the USPTO acknowledges receipt of the following documents:

1. PTO Transmittal Letter (*in duplicate*);
2. Information Disclosure Statement (*in duplicate*);
3. Form PTO-1449 (5 sheets citing 51 documents); and
4. 51 documents cited in Form PTO-1449.



Please Date Stamp And Return To Our Courier

MDC

Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, NW
Washington, DC 20005-3934



STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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NANCY J. LEITH**
TARJA H. NAUKKARINEN**

*BAR OTHER THAN D.C.
**REGISTERED PATENT AGENTS

March 9, 2000

WRITER'S DIRECT NUMBER:
(202) 371-2560

INTERNET ADDRESS:
RESMOND@SKGF.COM

Assistant Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Utility Patent Appl. No. 09/438,365; Filed: November 12, 1999
For: **New Transfection Reagents**
Inventors: Chu *et al.*
Our Ref: 0942.4650001/RWE/THN

Sir:

Applicants submit the following documents for appropriate action by the U.S. Patent and Trademark Office:

1. Information Disclosure Statement (*in duplicate*);
2. Form PTO-1449 (5 sheets citing 51 documents);
3. 51 documents cited in Form PTO-1449; and
4. One (1) return postcard.

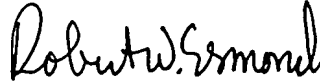
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Assistant Commissioner for Patents
March 9, 2000
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge all requisite fees to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

RWE/THN/lam

Enclosures